Patent

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicants: PICKOVER et al.

Application No.: 09/785,572

Filing Date: February 16, 2001

For: METHOD AND APPARATUS FOR SUPPORTING SOFTWARE

Group Art Unit: 2113

Examiner: Puente, Emerson C.

REPLY BRIEF

Attorney Docket No.: I01.008
(IBM Ref. YOR920010037US01)

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CERTIFICATE OF MAILING UNDER 37 CFR 1.8

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Dated: September 9, 2004 By: Edith Martin

Mail Stop Appeal Brief - Patents
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Appellants file this reply to the Examiner's Answer mailed on August 2, 2004.

For the most part the Examiner's Answer does not break new ground, and Appellants will rest on the points made in the Appeal Brief, except for a few additional comments set forth below.

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(A) The Examiner continues to rely on the Othmer reference as supposedly teaching the concept of providing solutions for user errors,[1] even though Othmer actually fails to contain this teaching. Applicants will note once more that the only passage in Othmer that deals with user errors is at Column 7, lines 45-55, and that this passage does not teach or suggest providing solutions for user errors.

The Examiner attempts to bolster his position by now citing, out of context, a passage at Column 2, lines 55-60 in Othmer as supposedly teaching the concept of providing solutions to user errors. However, if this passage is considered within the teachings of Othmer as a whole, and particularly with consideration to the language that immediately precedes the passage, it becomes evident that this passage deals with software errors ("bugs"), not user errors. To make this point clear, Appellants reproduce below the entire relevant passage, encompassing lines 52-62 of Column 2.

> During beta testing, the system also provides accurate feedback about errors or defects in a software application and permits a developer to accurately recreate an error in order to determine a proper solution to the error which reduces the need for quality assurance people. In addition, for an end user support environment, as the system or the developer determines solutions for an error, the system may generate automatic rules that send automatic messages to the user that indicate the solution to the known error which reduces the need for customer support people. [Emphasis added]

Neither this passage nor any other part of Othmer supports the Examiner's contention that Othmer teaches providing patches for user errors.

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(B) The Examiner states that Appellants' "inventive concept is a system that provides patches in general".[2] Here the Examiner errs in failing to consider the currently presented claim

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[1] See, e.g., Examiner's Answer at page 13, lines 3-6 and lines 13-15; page 4, lines 11-15; page 14, lines 8-10.
[2] Examiner's Answer, page 11, lines 13-14.

language, which sets forth the scope of the invention for which protection is now sought. As the CAFC has stated, "the name of the game is the claim".[3] The present claim language specifically calls for providing patches for user errors. This limitation is supported by the specification, and is not taught or suggested by the prior art of record. That broader coverage was previously sought, or would have been supported by the specification (if available in view of prior art), is irrelevant. The fact remains that the present application teaches, and now claims, providing patches for user errors, and the prior art does not so teach.

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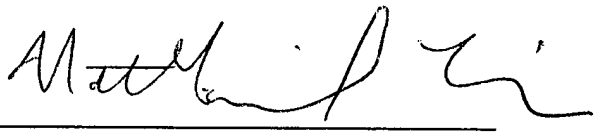
As required by 37 CFR §1.192(a), this Reply Brief is filed within two months from the date of mailing of the Examiner's Answer (*i.e.*, within two months of August 2, 2004). As such, no extension of time is believed due. However, if any additional fees are due in conjunction with this matter, the Commissioner is hereby authorized to charge them to Deposit Account 50-0510.

If any issues remain, or if the Examiner or the Board has any further suggestions for expediting allowance of the present application, kindly contact the undersigned using the information provided below.

Respectfully submitted,



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[3] *In re Hiniker Co.*, 150 F.3d 1362,1369 (Fed Cir. 1998).